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Date of Deposit: Dec. 27, 2006

By:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 27435.002

In Re Application of:

Smith, Dwight M.

Examiner: **Zheng, Lois L.**

Serial No. **10/768,613**

Art Unit: **1742**

Filed: **January 30, 2004**

For: **Method and Composition for
Creation of Conversion Surface**

RESPONSE TO OFFICE ACTION DATED SEPTEMBER 28, 2006

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Madam:

In response to the Office Action dated September 28, 2006, Applicant respectfully Applicant respectfully selects Group II with traverse. Applicant respectfully submits that the claims of Group II as identified by the Examiner are tied to the compositional claims of Group I, and in fact directly reference the composition of claim 1. MPEP 803.01 establishes that "[t]here are two criteria for a proper requirement for restriction between patentably distinct invention:

- (1) The invention must be independent ... or distinct as claimed ...; and
 - (2) There must be a serious burden on the examiner if restriction is not required..."
- MPEP 803.01.

Applicant respectfully submits that, due to the tying nature of the claims, there would be no "serious burden" on the Examiner to search the claims together. Furthermore, in that claim 14 incorporates claim 1, it is not possible to examine the claims of Group II without in fact considering Group I.

Group III is tied to Groups II and, respectively, to Group I. Group III calls out claim 14 as part of claim 21. Group IV (two claims) is tied to Group I in the manner noted above. Group V (one claim) is tied to Group IV and thus to Group I. Group VII is tied to Group I. Reconsideration of the restriction and consideration of all of the claims is respectfully requested.

A Request for Two-Month Extension of Time is included and a check in the amount of \$225. The Commissioner is authorized to charge BRACEWELL & GIULIANI LLP, Deposit Account 50-0259 (27435.002) for any *additional* fee(s) that may be required.

Date:

Dec 27, 2006

Respectfully submitted,



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